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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,331	01/02/2004	Andrew R. Heiges	009974-5054US01	7616
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MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER SUBRAMANIAN, NARAYANSWAMY	
			ART UNIT	PAPER NUMBER
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			07/25/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/751,331	<b>Applicant(s)</b> HEIGES ET AL.	
	<b>Examiner</b> Narayanswamy Subramanian	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to applicants' communication filed on May 13, 2008.

Amendments to claims 3, 4 and 8 and cancellation of claims 2 and 6 have been entered.

Rejections made under 35 USC § 112 are withdrawn in view of the amendments. Claims 1, 3-5 and 7-8 are currently pending in the application and have been examined. The rejections and response to arguments are stated below.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yinbal (US Patent 6,424,952 B1) in view of Corlett et al. (US Patent 6,253,192 B1).

Claims 1 and 5, Yinbal discloses a computerized method and system for analyzing college savings plans, the method for use with a computer-readable medium (See Yinbal Column 9 line 65 – Column 10 line 18, a computer-readable medium is inherent in the disclosure, educational funding and counseling services is interpreted to include college savings plans) on which are stored a plurality of educational institution identifiers and a plurality of educational savings plan parameter sets, each of respective educational institution identifiers being associated with a corresponding cost parameter set specifying at least one of room, board, and tuition costs for the respective educational institution; each of the plurality of educational savings plan

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parameters specifying one or more financial characteristics of a corresponding educational savings plan; the method comprising the steps of: a. receiving at least one educational institution identifier (See Yinbal Figure 1, Column 2 line 65 – Column 3 line 46); b. for each of the educational institution identifiers received in step (a), retrieving the corresponding cost parameter set from the computer-readable medium (See Yinbal Figure 1, Column 4 lines 13-65); c. generating a comparative analysis of a plurality of educational savings plans by applying each of the retrieved cost parameter sets of step (b) to each of the plurality of educational savings plan parameters (See Yinbal Figure 1, Column 10 line 61 – Column 11 line 15); and (d) outputting a report of the comparative analysis (See Yinbal Figure 1, Column 9 line 46 – Column 10 line 21).

Yinbal does not explicitly teach the limitation of “the comparative analysis taking into account one or more taxation implications for at least one of the educational savings plans”.

Corlett teaches the limitation of the comparative analysis taking into account one or more taxation implications for at least one of the educational savings plans (See Corlett Abstract, Figures 1B-2, Column 8 lines 38-44, Column 14 lines 60-67, Claims 1, 11-13, the planning rules are interpreted to include savings plan parameters for financial plans).

Both Yinbal and Corlett are concerned with the problem of financial planning for meeting certain financial objectives. It would have been obvious to one of ordinary skill in the art at the time of invention to include the teachings of Corlett to the invention of Yinbal. The combination of disclosures suggested that users would have benefited from using a model that would enable them to achieve their financial objectives.

Claims 3-4 and 7-8, Corlett teaches the features of generating a comparative analysis further includes comparing each of a plurality of financial plans with reference to one or more

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specific asset allocations and a comparison based upon tax considerations (See Corlett Column 8 lines 38-44, Column 14 lines 60-67, Claims 1, 11-13, changing preferences and allocations is interpreted to include these features).

***Response to Arguments***

4. Applicant's other arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are included on the enclosed PTO-892.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached at (571) 272-6771. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Narayanswamy Subramanian/

Primary Examiner

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July 20, 2008